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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,370

01/22/2004

David Wallach

WALLACH=27A

3756

1444

7590

11/01/2005

BROWDY AND NEIMARK, P.L.L.C.  
624 NINTH STREET, NW  
SUITE 300  
WASHINGTON, DC 20001-5303

EXAMINER

RIGGINS, PATRICK S

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/761,370

Applicant(s)

WALLACH ET AL.

Examiner

Patrick S. Riggins

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 5, drawn to antibodies against RAP-2 and a method of using those antibodies, classified in class 530, subclass 387.9.
  - II. Claims 2, 12, and 13, drawn to a method for modulating RIP activity using RAP-2 protein, classified in class 514, subclass 2.
  - III. Claims 2-4, 9, 12, and 13, drawn to a method for modulating RIP activity including in disease cells using DNA encoding RAP-2, classified in class 514, subclass 44.
  - IV. Claims 6-8 and 11, drawn to antisense molecules and method of using those antisense molecules to modulate RIP activity, classified in class 435, subclass 375.
  - V. Claim 10, drawn to a method for modulating RIP activity using ribozymes against RAP-2, classified in class 435, subclass 375.
  - VI. Claim 14, drawn to a method of identifying RAP-2 interacting proteins with the yeast two-hybrid system, classified in class 435, subclass 7.31.
  - VII. Claims 15 and 16, drawn to methods of modulating RAP-2 function, classified in class 435, subclass 375.

The inventions are distinct, each from the other because of the following reasons:

2. Each of Groups I-V is distinct from the others because each group is drawn to a distinct method that uses different reagents and thus different method steps. Groups I-V are all drawn to

Art Unit: 1633

methods of modulating RIP activity by manipulating RAP-2 levels. Group I uses antibodies, Group II uses protein, Group III uses DNA encoding the protein, Group IV uses antisense, and Group V uses ribozymes. Each of these reagents is chemically and functionally distinct and one reagent cannot be directly substituted for the other. Additionally the methods of Groups I, IV and V would appear to act to downregulate RAP-2 levels, while Groups II and III would seem to upregulate RAP-2 levels. It is thus clear that each method of modulating RIP activity is patentably distinct.

3. Group VI is distinct from each of Groups I-V because the claims of the Groups are drawn to distinct methods, utilizing different method steps, with a different, unrelated outcome. As discussed above each of Groups I-V is drawn to a method of modulating RIP activity by modulating RAP-2 levels. These Groups use antibodies, proteins, DNA, antisense, or ribozymes. Group VI is drawn to a method of identifying interaction partners for RAP-2. This method uses yeast cells and DNA fusion constructs. It is thus clear that the methods of Groups I-V and Group VI are distinct in both the method steps performed in the execution of the methods and the desired outcome of the methods are divergent.

4. Group VII is distinct from each of Groups I-V because the claims of Groups are drawn to distinct methods, utilizing different method steps with different expected outcome. Groups I-V are each drawn to methods of modulating the *level* of RAP-2 to influence RIP activity while the method of Group VII is drawn to a method for modulating the *activity* of RAP-2. Furthermore, the methods of Groups I-V each utilize some form of a reagent related to RAP-2 itself, while the method of Group VI utilizes other reagents chemically, structurally, and functionally distinct from RAP-2. Thus, Group VII shares no reagent or method step with any of Groups I-V.

Art Unit: 1633

5. Group VI is distinct from Group VII because the claims of the Groups are drawn to distinct methods, utilizing different method steps, with a different, unrelated outcome. As discussed above Groups VII is drawn to a method of modulating RAP-2 activity using proteins. Group VI is drawn to a method of identifying interaction partners for RAP-2. This method uses yeast cells and DNA fusion constructs. Group VI shares no method steps with Group VII and the expected out come of Group VI is distinct from the expected outcome of Group VII.

6. As each of the Group I-VII uses distinct reagents, different method steps, and different expected outcomes, it is clear that a search of the reagents used in each of the methods will not necessarily return results applicable to the other Groups. Furthermore, to search for the different methods, i.e. the different expected outcomes would necessarily fail to identify applicable art between many of the Groups. Thus, to search each of the Groups would be burdensome. Because these inventions are distinct for the reasons given above and the searches required for Groups I-VII are not coextensive, restriction for examination purposes as indicated is proper.

### *Conclusion*

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1633


application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick S. Riggins whose telephone number is (571) 272-6102. The examiner can normally be reached on M-F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave T. Nguyen can be reached on (571) 272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick Riggins, Ph.D.  
Examiner  
Art Unit 1633



**RAM R. SHUKLA, PH.D.**  
**SUPERVISORY PATENT EXAMINER**